REMARKS

Status and Amendment of Claims

Claims 1-10, 12-28, and 31-39 are currently pending in this application. Applicant has amended claims 12 and 16 to make them dependent upon claim 1. Applicant has amended claims 29 and 30 to make them dependent upon claim 28. Applicant has amended claims 31-36 by changing "product of the process" to "hydrous kaolin pigment" and by amending claims 31 and 33 so they no longer depend from claims 29 and 30. No new matter is added by those amendments and Applicant respectfully requests that they be entered without objection.

Applicant acknowledges, with appreciation, the Office's withdrawal of: (1) the provisional obviousness-type double patenting rejection over co-pending Application Serial No. 10/889,315; (2) the rejection of claims 1-3, 6-10, 12-14, 16-22, 24-28, and 37-39 under 35 U.S.C. § 102(b) over Chapman et al. (U.S. Patent No. 4,227,920); and, (3) the rejection of claims 1-10 and 12-23 under 35 U.S.C. § 102(b) over Maynard (U.S. Patent No. 3,857,781). *See* Office Action at 2. Applicant addresses the remaining rejections below in support of the patentability of the pending claims, as amended.

Rejection under 35 U.S.C. § 112, Second Paragraph

The Office rejected claims 31-36 under 35 U.S.C. § 112, second paragraph, on the ground of indefiniteness, because claims 31-36 allegedly depend improperly from the product-by-process claims 28-30. *Id.* at 3. Applicant amended claims 31-36, as suggested by the Office, to read "hydrous kaolin pigment" as opposed to "product of the process." That amendment obviates the Office's rejection and Applicant respectfully requests that the rejection be withdrawn.

Provisional Double Patenting Rejection

The Office provisionally rejected claims 1-10 and 12-39 on the ground of non-statutory, obviousness-type double patenting over claims 15, 47-52, 57, 61, 67, and 69 of co-pending Application Serial No. 10/511,203 ("the '203 application"). *Id*. at 4. While Applicant does not necessarily agree with the Office's rejection, Applicant has submitted herewith a proper Terminal Disclaimer over the '203 application. The Terminal Disclaimer obviates the obviousness-type double patenting rejection and, therefore, Applicant respectfully requests that it be withdrawn.

Rejection under 35 U.S.C. § 102(b)

The Office maintained its rejection of claims 29 and 31-35 under 35 U.S.C. § 102(b) as allegedly anticipated by Chapman et al. (U.S. Patent No. 4,227,920). *Id*. at 5. The Office also maintained its rejection of claims 29-34 under 35 U.S.C. § 102(b) as allegedly anticipated by Maynard (U.S. Patent No. 3,857,781). *Id*. at 6. While Applicant does not necessarily agree with the Office's rejection, merely in an effort to expedite prosecution Applicant has amended claims 29-35 so they depend from non-rejected claim 28. In light of this rejection, although Applicant does not necessarily agree or believe it necessary for patentability, Applicant has also amended claims 12 and 16 to be dependent from claim 1. Applicant respectfully asserts that those amendments obviate any rejection of the pending claims, as amended, under 35 U.S.C. § 102(b) over the cited references and Applicant requests that the Office withdraw the rejections.

Rejections under 35 U.S.C. § 103(a)

The Office rejected claims 1-7, 12-15, and 24-39 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,808,559 ("the '559 patent"). The Office also rejected those same claims as allegedly obvious over U.S. Patent Application Publication No. 2005/0098283 ("the '283 publication"). *Id*. at 7 and 9. Applicant respectfully traverses those rejections as both the '559 patent and the '283 publication do not qualify as prior art for 35 U.S.C. § 103(a) by operation of 35 U.S.C. § 103(c).

According to 35 U.S.C. § 103(c),

> [s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As the Office has admitted, the '559 patent and the '283 publication only qualify as prior art against the instant application under 35 U.S.C. § 102(e). *See* Office Action at 8 and 9. Applicant submits that, at the time the presently claimed inventions were made, the subject matter of the '559 patent, the '283 publication, and the present claims were subject to an obligation of assignment to Imerys Pigments, Inc., as evidenced by the assignment information for the '559 patent and the '283 publication recorded on April 9, 2003, at Reel 013942, Frame 0513, and the assignment information for the instant application recorded on September 23, 2004, at Reel 016503, Frame 0634.

As the '559 patent and the '283 publication are therefore not available as prior art under 35 U.S.C. § 103(a) pursuant to the exclusionary provision of 35 U.S.C. § 103(c), Applicant respectfully requests withdrawal of this rejection.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and the continued examination of this application and the timely allowance of the pending claims. Should the Office have any questions regarding this application, or wish to discuss any amendment or argument made herein, Application invites the Office to contact the undersigned representative.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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